



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,629	03/23/2000	RAZI VAGO	229752001000	2656

7590 09/13/2006

MORRISON & FOERSTER
2000 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20006-1888

EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
----------	--------------

3738

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/446,629

Applicant(s)

VAGO, RAZI

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to the Applicant's Remarks

With regard to the objection to the specification as set forth in the Office action mailed on May 15, 2006, the Applicant's comments are persuasive. The omitted letters in the initial file copy of the specification appear to be due to an error by a USPTO fax machine. Moreover, the present application, as noted by the Applicant, is the national stage of an international PCT application (corresponding to WO 99/02200 A1). The Applicant's substitute specification, accompanied by the statement that the substitute specification does not contain any new matter, is therefore sufficient to overcome the objection to the specification.

The examiner has very recently been informed of the particulars of USPTO policy on issues pertinent to the instant application. There does not appear to be any requirement for a transitional term or phrase, so the Applicant is deemed to be correct on this issue. In order to make the record clear, the examiner hereby interprets claim 4 as being inclusive or open-ended (MPEP § 2111.03), especially because the product can include additional elements such as a therapeutically active substance (claim 8). However, in view of USPTO policy on claim interpretation, the application as currently filed cannot be allowed, for reasons presented below.

Claim Rejections

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-7 and 11 are rejected under 35 U.S.C. 101 because the claim language "shaped into a form ..." (claim 4, line 2) is broad enough to encompass the *natural* shape of the coral skeletons, which are *capable* of being implanted or inserted into a large mammal (whale, elephant, etc.) in order, for example, to evaluate tissue response (for medical research) along an

unaltered, structurally intact coral surface. An article of manufacture occurring in nature will not be considered patentable unless given a new form, quality, properties, or combination not present in the original article existing in nature (*Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 76 USPQ 280 (1948); *American Fruit Growers v. Brogdex*, 283 U.S. 1, 8 USPQ 131 (1931); *Ex Parte Grayson*, 51 USPQ 413 (Bd. App. 1941)). Under USPTO policy, any claim that is reasonably interpreted as covering embodiments which are statutory and embodiments which are non-statutory should be rejected. Regarding claims 5 and 6, “spacer” (claim 6, line 2) is broad enough to encompass virtually any solid occupying a volume and hence *capable of* “spacing apart” two or more (unclaimed) elements. Regarding claim 11, the coral itself is viewed as an assembly of coral skeletons.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 4, line 1, “or related purposes” renders the claim indefinite as to the scope because it is not clear what the Applicant intends to cover by the recitation “*related purposes*” (emphasis added); attention is directed to MPEP § 2173.05(b), especially sections C and F. Similar problems occur in claims 5 and 6.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3738

Claims 4-7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by AIMS, *CORAL GROWTH: Laser Based Underwater and Laboratory Measurements*, last updated on March 6, 1997. The species *Acropora grandis* possesses natural sizes and shapes *capable* of being implanted or inserted into a whale for medical purposes, such as studies on digestion or tissue response, and skeletal portions of said coral are *capable* of being implanted in humans, whether or not such was the intent. The naturally occurring structure meets all the limitations of claims 4-7 and 11 for reasons explained in the above rejection under 35 U.S.C. 101.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and sometimes on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse
Primary Examiner
Art Unit 3738